

**REMARKS**

**I. Status of Claims**

As reflected in the Listing of Claims, claims 3-5, 8-10, 37, and 74-97 are pending in this application. Claims 12-17 and 52-56 have been withdrawn from consideration as being directed to non-elected subject matter; claims 1, 2, 6, 7, 11, 18-36, 38-51, and 57-73 have been canceled, without prejudice of disclaimer; claims 3-5, 8-10, and 37 have been amended; and claims 74-97 have been newly added.

In the Office Action dated September 9, 2005, the Examiner required restriction under 35 U.S.C. § 121 between the following grouping of claims: Group I, claims 1-11, 18-51, and 57-73; and Group II, claims 12-17 and 52-56. In the Office Action, the Examiner also objected to claims 33-36 and 45; rejected claims 5 and 23 under 35 U.S.C. 112, second paragraph; rejected claims 1-4, 6, 11, 38-41, 46, and 47 under 35 U.S.C. 102(e) as being anticipated by *Reynolds et al.* (U.S. Patent No. 6,799,327); rejected claims 5 and 48 under 35 U.S.C. 103(a) as being unpatentable over *Reynolds et al.* in view of *Zigmond et al.* (U.S. Patent No. 6,698,020); rejected claim 7 under 35 U.S.C. 103(a) as being unpatentable over *Reynolds et al.* in view of *Hite et al.* (U.S. Patent No. 6,002,393); rejected claims 8 and 49 under 35 U.S.C. 103(a) as being unpatentable over *Reynolds et al.* in view of *Ward et al.* (Published U.S. application 2005/0010949); rejected claims 9, 10, 50, and 51 under 35 U.S.C. 103(a) as being unpatentable over *Reynolds et al.* in view of *Ward et al.* and further in view of *Zigmond et al.*; rejected claims 42-45 under 35 U.S.C. 103(a) as being unpatentable over *Reynolds et al.* in view of *Ellis et al.* (Published U.S. application 2004/0194131); rejected claims 18, 32, 57, 71, and 73 under 35 U.S.C. 103(a) as being unpatentable

over *Reynolds et al.* in view of *Knee et al.* (Published U.S. application 2002/0095676); rejected claims 19-22, 27, 33, 36, 58, 59-61, 66, and 72 under 35 U.S.C. 103(a) as being unpatentable over *Reynolds et al.* in view of *Knee et al.* further in view of *Hite et al.*; rejected claims 23-26 and 62-65 under 35 U.S.C. 103(a) as being unpatentable over *Reynolds et al.* in view of *Knee et al.* further in view of *Hite et al.* and *Ellis et al.*; rejected claims 28 and 67 under 35 U.S.C. 103(a) as being unpatentable over *Reynolds et al.* in view of *Knee et al.* further in view of *Hite et al.* and *Zigmond et al.*; rejected claims 29-31 and 68-70 under 35 U.S.C. 103(a) as being unpatentable over *Reynolds et al.* in view of *Knee et al.* further in view of *Hite et al.*, *Zigmond et al.*, and *Ward et al.*; rejected claim 34 under 35 U.S.C. 103(a) as being unpatentable over *Reynolds et al.* in view of *Knee et al.* further in view of *Beyers et al.* (U.S. Patent No. 5,943,467) and *Darbee et al.* (Published U.S. application 2002/0184626); rejected claim 35 under 35 U.S.C. 103(a) as being unpatentable over *Reynolds et al.* in view of *Knee et al.* further in view of *Beyers et al.*, *Darbee et al.* and *Hite et al.*; and rejected claim 37 under 35 U.S.C. 103(a) as being unpatentable over *Reynolds et al.* in view of *Knee et al.* further in view of *Hite et al.* and *Darbee et al.*

## **II. Response to Restriction Requirement**

In the Office Action, the Examiner required restriction under 35 U.S.C. § 121 between the following groups of claims:

Group I, claims 1-11, 18-51, and 57-73; and

Group II, claims 12-17 and 52-56.

(See *Office Action*, p. 2.) According to the Examiner, the inventions listed above are related as subcombinations which are distinct from each other because they are

separately usable. (See *Office Action*, p. 2.) While Applicant respectfully disagrees with the restriction requirement, Applicant confirms the provisional election of Group I, claims 1-11, 18-51, and 57-73, with traverse. Applicant respectfully requests reconsideration of the restriction requirement in view of the following remarks.

According to MPEP § 803, there are two requirements that must be met before a proper restriction requirement may be made: (1) the inventions must be independent or distinct as claimed; and (2) there must be a serious burden on the Examiner if restriction is not required. Applicant respectfully submits that the Office has failed to establish the second requirement set forth in MPEP § 803, that a serious burden exists on the Examiner if restriction is not required between the Groups of claims.

In the present invention, Groups I and II both relate to the distribution of electronic information containing an interactive advertisement. Therefore, proper search of the subject matter of Group I would include the subject matter of the claims of Group II, and vice versa. For at least this reason, the Examiner cannot show there would be a serious burden to examine the claims recited in both Groups I and II.

In view of the foregoing remarks, Applicant respectfully requests that the restriction requirement be withdrawn and the claims of Group I and Group II be examined together.

### **III Claim Objections**

In the Office Action, the Examiner objected to claims 33-36 and 45 because of informalities in the claim language. With this response, Applicant has canceled claims 33-36 and 45, consequently, Applicant submits that the objections to these claims are moot.

**IV. Rejections under 35 U.S.C. § 112, second paragraph**

In the Office Action, the Examiner rejected claims 5 and 23 under 35 U.S.C. § 112, second paragraph as failing to particularly point out and distinctly claim that which Applicant regards as the invention. With this response, Applicant has canceled claim 23, consequently, Applicant submits that the rejection of this claim is now moot. With respect to claim 5, Applicant has amended claim 5 to depend from 4 with provides support for the claim language of claim 5. Applicant thereby respectfully request that the § 112 rejection of claim 5 be withdrawn.

**VI. Rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a)**

The Examiner rejected claims 1-4, 6, 11, 38-41, and 46-47 under 35 U.S.C. § 102(e) as being anticipated by *Reynolds et al.* The Examiner further rejected claims 5, 7-10, 18-37, 42-45, 48-51, and 57-73 under multiple § 35 U.S.C. 103(a) rejections with *Reynolds et al.* consistently being the primary reference.

Applicant respectfully traverses the rejections under 35 U.S.C. § 102(e) and 35 U.S.C. § 103(a). With this response, the existing independent claims are claims 74, 78, 88, 96, and 97. These claims are patentable over the cited references for at least the following reasons.

*Reynolds et al.* teaches a system and method for mixing advertisements and pseudo-ads within a viewing guide of a set-top box. (See, *Abstract.*) *Reynolds et al.* further discloses wherein the regular advertisements and pseudo-ads are either transmitted to the set-top box or generated and stored at the set-top box. (See, *Reynolds et al.*, col. 3, lines 1-9.) Applicant submits that *Reynolds et al.* does not teach or suggest “an electronic gaming console” or “a computing unit” of a hand held terminal

device “adapted to retrieve the interactive advertisements and broadcast information from the first storage device, store the interactive advertisements and broadcast information in a second storage device, and process either the interactive advertisements or broadcast information for display based on a user selection,” as recited in claims 74 and 78. The additional cited art of record also fails to disclose this claimed subject matter.

New claim 88 relates to a method of displaying interactive advertisements and broadcast information. *Reynolds et al.* discloses wherein multiple layouts of a program guide are possible. For example, *Reynolds et al.* discloses wherein the program guide may simultaneously display video content and advertisements. (*Reynolds et al.*, col. 9, lines 30-32.) However, *Reynolds et al.* fails to disclose “initially displaying a spot advertisement and not broadcast information in response to a user selecting to view broadcast information,” as recited in claim 88. The additional cited art of record also fails to disclose this claimed subject matter.

New claims 96 and 97 relate to an electronic gaming console and hand held processing apparatus comprising three user selectable modes, “a game mode,” “a program reproduction mode,” and an “interactive advertisement operating mode.” *Reynolds et al.* and the cited prior art of record also fails to disclose this claimed subject matter.

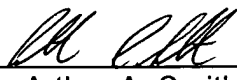
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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